

**b. Remarks**

The pending Office Action indicated that the inventor's declaration filed  
5 on 08/22/06 under 37 CFR § 1.131 was ineffective to overcome Levine et al as a  
reference under 102 (e) because of the nature of the averments in the declaration and the  
nature of the attachments, namely:

- (1) a copy of the provisional application specification;
  - (2) a copy of a cover page of a specification of the invention bearing the date  
10 November, 1985;
  - (3) a copy of an assignment of the invention dated December 14, 1984;
  - (4) a copy of a faxed four-page hand written description of the invention dated  
May 25, 1995; and,
  - (5) a copy of a non-disclosure agreement dated Aug. 1, 1996
- 15 were found by the Examiner not to be sufficient to establish a "reduction to practice of  
the invention" in this country or a NAFTA or WTO member country prior to December  
31, 1998, the effective date of Levine et al. Applicant interprets this to mean that the  
affidavit failed to indicate the making of the invention, and did not mention that this  
occurred in the United States.

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The factual and legal basis for the Examiner's finding of ineffectiveness is believed to  
be indicated as:

- (i) The declaration is a general allegation. A general allegation that the invention

was completed prior to the date of the reference is not sufficient. Ex parte  
Saunders, 1883 C.D. 23, 23 O.G. 1224 (Comm'r Pat. 1883)<sup>1</sup>. Similarly, a  
declaration by the inventor to the effect that his or her invention was  
conceived or reduced to practice prior to the reference date, without a  
5 statement of facts demonstrating the correctness of this conclusion, is  
insufficient to satisfy 37 CFR 1.131; and,

- (ii) 37 CFR 1.131(b) requires that original exhibits of drawings or records, or  
photocopies thereof, accompany and form part of the affidavit or declaration  
10 or their absence satisfactorily explained.

This Amendment B with the accompanying supplemental Affidavit overcomes  
the reasons for refusal to accept the original 131 declaration as proof of conception and  
reduction to practice.

The issue is whether the invention recited in the new claims is taught by the  
15 1985 Specification explained in the supplemental 131 affidavit. The affidavit  
combined with the declaration clearly establishes that the invention was conceived  
prior to November of 1985 and was constructively reduced to practice in the 1985  
Specification. The Courts have recently held that an invention is reduced to practice  
when it is ready for patenting.  
20 It is ready for patenting when it is described in a writing describing the invention in a

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<sup>1</sup> Applicant's counsel's attempt to locate a copy of this precedent cited by the Examiner were unsuccessful due to its age and lack of publication in a reporter other than a 125 year old O.G. Efforts to locate the reference are ongoing. However, as the time response closed we have been unsuccessful. Accordingly, a fax of a copy of the Examiner's copy of this reference is requested.

way that teaches one of ordinary skill in that art how to practice the invention, namely, it satisfied the requirements of 35 USC §112, ¶1. It is submitted that the Examiner will agree after close examination that the 1985 Specification is such a writing.

5           The Rule 131 affidavit incorporates two (2) original documents and one best  
available but true copy of a document. Each is dated prior to the December 31, 1998  
effective date of the Levine Patent as well as the effective dates of Fraser et al and  
Teagel et al. The two (2) originals are non-disclosure agreements signed in the first half  
of 1985 by two persons. Of particular evidentiary value is the fact that each has an  
10 "original Exhibit A" attached reciting a summary of the invention. The summary states:

15                    "The BAMA Concept relates to an Auction Market wherein banks and other entities act as agents for borrowers and lenders. Through a state of the art computer system network, potential borrowers and potential lenders are put in direct contact with one another through an auction process set forth on the computer screen. The banks act as guarantors for the promissory paper generated as a result of the closed transactions.

20 It is understood that this concept as set forth above is in the most general form and that there is greater detail to it to be provided under the non-disclosure statement."

At minimum, these originals indisputably establish facts showing conception of the invention recited in new claims 6 -19 before November 30, 1985.

25 Proof of the existence of a document (hereinafter referred to as the "1985 Specification") that avers, teaches, suggests, and intimates the inventions in claims 6-19 is clearly established by the facts in the supplemental affidavit at ¶ 6. Thus, the inventions recited in claims 6-19 were "ready for patenting" in 1985. The affidavit at

¶5 and ¶6 proves that the applicant is indeed the inventor and that he made the invention in the "United States".

The inability to attach the original of the 1985 Specification has been factually shown by affidavit to be excusable. The inventor testifies that he cannot locate the original 1985 Specification and that the attached copy with "BAMACORP November, 1985" on the cover page is a true copy of the document as typed. Affidavit, ¶3,4. The affidavit proves the following facts, namely, that a plurality of copies of the original 1985 Specification were made in 1985 and that the attached specimen is a true copy of the typed part with no typed deletions or additions.

Careful examination of this 1985 specification shows one of skill in this art a detailed plan of the utility, mathematical basis, and workings of the invention and that it merely requires a group of computers with monitors. These computers are specified as connected to each other or interconnected.

An invention is "ready for patenting" if it has been described in an enabling disclosure. Netscape Communications Corp. v. Konrad, 295 F.3d 1315 (Fed. Cir. 2002); In re Buspirone Patent Litigation, 185 F. Supp. 2d 340 (S.D.N.Y. 2002). Thus, applicant argues that the law supports a finding that the secret document with "BAMACORP November, 1985" on the front cover, namely, the "1985 Specification", shows the invention to be ready for patenting for non-internet use and therefore evidences a reduction to practice of the inventions recited in claims 6 - 19. The Federal Circuit has equated the term "invention" in sections of 102 with a "ready for patenting"

standard established by the Supreme Court in *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55,60 (1998). See also *Invitrogen Corp. v. Biocrest Manufacturing, L.P.*, No. 04-1273 ¶25, ¶26, and ¶27(Fed. Cir. 10/05/2005.)<sup>2</sup>. There is no bar to an inventor or assignee keeping an invention secret and not subjecting it to commercial use for an extended period of  
5 time and then seeking a patent. *Id* at ¶34.

The 1985 Specification in the introduction on pages 1 and 2 teaches use of the method and system over a private network using terminals provided by a private corporation. It does not specifically teach that the Internet is absolutely necessary to  
10 enable the system and method.

The Rule 131 supplemental affidavit submitted herewith is respectfully requested to be entered into the record. In this declaration applicant establishes a date of invention", namely, conception and reduction to practice in the United States on or  
15 before November 30, 1985 via the United States corporate entity Bamacorp. Further improvements to the invention are evinced as being made on or before May 25,1995. The applicant's invention therefore occurred prior to the priority date of Levine et al. Hence, Levine et al. is not a prior invention under 102(e).

Claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over Levine  
20 in view of Fraser et al (US Patent No. 5,995,947). Levine et al and Fraser are both

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<sup>2</sup> [T]he Court's analysis of the statutory term "invention," equated it to a "ready for patenting" test or prong, and indicates it applies to both of the other parts of section 102(b), "on sale" and "public use." Here the invention was ready for patenting but kept secret for a long period.

verily believed to be shown by competent and compelling evidence not to be prior art. Hence, the rejection of the claimed subject matter as obvious over Levine et al combined with Fraser et al cannot be substantiated on the facts now presented.

5           Claims 6-20 clearly recite patentable subject matter that was kept secret up until filing of the provisional application in 2000.

          That the inventor's assignee Bamacorp kept the invention secret until the June 15, 2000 filing date of the provisional is of no consequence to obviating the Levine  
10   reference cited under 102(e) to reject prior claims 1- 5. Diligence is not an issue here. The invention was kept confidential by the assignee from the date of the conception and reduction to practice until it was decided to file a provisional, and then the non-provisional that is the subject of this action.

15           In order to remove the Levine et al patent as Section 102(e) prior art, applicant need only prove that the claimed invention was ready for patenting prior to December 31, 1998. An applicant for a patent may disqualify a prior art reference cited as showing the applicant's invention by establishing "completion of the invention in this country" prior to the effective date of the reference. This requirement is clearly met by  
20   showing prior completion of the entire invention as it is later claimed. And, according to Judge Lifland's examination of Rule 131, it can also be met by showing prior possession of as much of the invention as is disclosed in the reference, or prior "possession of such knowledge as to make the entire invention or that part obvious to one with ordinary skill

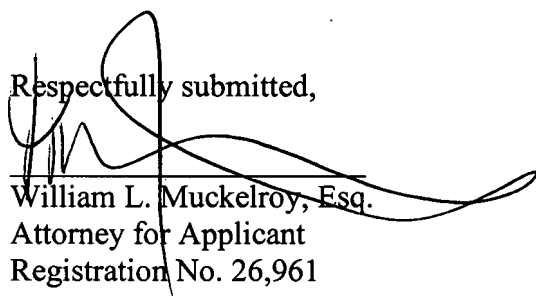
in the art." Pfizer Inc. v. Teva Pharmaceuticals USA, Inc., No. 04-754 at ¶29 (D.N.J. 10/25/2006) citing In re Stempel, 241 F.2d 755 (CCPA 1957). Also, see 3 Chisum on Patents § 3.08[1][b][ii], at 238.

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Enclosures: Amendment B, Supplemental Rule 131 Affidavit with two (2) original documents and one true copy attached, Certificate of Mailing; Petition for Three-Month Extension with fee via attorney's check for \$510.

20 cc: Bamacorp